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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,891	02/02/2001	Eric A. Baldwin	04608.00002	8122

22908 7590 03/09/2004

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EXAMINER

ODLAND, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 03/09/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/775,891

Applicant(s)

BALDWIN ET AL.

Examiner

Kathryn Odland

Art Unit

3743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 18, 34, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17, 19-33, 35 and 38-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

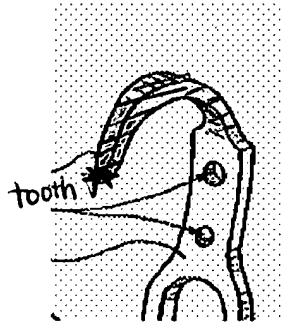
Response to Amendment/RCE

This is a response to the amendment/RCE dated December 8, 2003. Claims 1-17, 19-33, 35 and 38-49 are under consideration. The amendments to the specification are acknowledged.

Response to Arguments

1. Applicant's arguments filed December 8, 2003 have been fully considered but they are not persuasive.

Applicant argues, "Independent claims 1, 16, 32, and 38 have been amended to clarify the meaning of the term 'extension or hook.' These amendments clarify that the claw of the instant invention has at least one extension or hook that has at least one tooth that is adapted to impact into a bone, such as the bone of the greater trochanter, such that the claw can fixate the greater trochanter in position and is further stabilized by the cables. Neither Dall et al. nor Judet et al. discloses such a claw." However, Judet et al. clearly demonstrate a claw (denoted in red in the drawing below) that has at least one extension or hook (shown in green in the drawing below) that has at least one tooth (the tip of the hook) that is adapted to impact into a bone, such as the bone of the greater trochanter, such that the claw can fixate the greater trochanter in position, as seen clearly in figure 5.



Applicant further argues, "Dall et al. does not disclose a bone screw slot that is a compression-type slot, as claimed in claims 6 and 23 of the instant application. However, applicant's specification on page 10 recites, "Compression slots are generally known in the art." Applicant then defines a compression-type slot as that shaped such that as the bone screws are tightened, the screws are tightened, the screws will be biased in the slot towards the fracture line. Thus, although Dall et al. do not explicitly recite "compression-type slots," they are generally known in the art and would be obvious to one with ordinary skill in the art, as concluded by the specification on page 10.

2. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Dall et al. and Judet et al. demonstrate fixation devices where, as shown in figure 12 of Dall et al.,

there is motivation to combine the claw as taught by Judet et al. for the purpose of enhanced support. Claws for support are known in the art and would be an obvious modification to that shown in figure 12 of Dall et al.

Applicant also argues that the crimping method of Dall et al. is not equivalent to that of the instant invention. However, applicant has failed to establish the criticality to the crimping method of the instant invention. In fact, page 11 of the specification states, "The particulars of the cable mechanism are generally known in the art and disclosed in U.S. Patent No. 5,415,658." Therefore, the function of securing the cables is accomplished in the Dall et al. reference as well as the instant application. Therefore, it would have been obvious to one with ordinary skill in the art to crimp in any of the generally known crimping methods. Furthermore, functional language does not hold patentable weight in apparatus claims. Moreover, claim 13 recites "capable of crimping a cable." The phrase "capable of crimping" is not given patentable weight in an apparatus claim. It has been held that the recitation that an element is "capable" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Furthermore, driver slots and drivers are well known to those with ordinary skill in the art (see the additionally cited references in the last office action for a few examples). Therefore, it would be obvious to one with ordinary skill in the art to modify the invention to include such features.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17, 19-33, 35 and 38-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dall et al. in US Patent No. 5,665,089 in view of Judet et al. in US Patent No. 5,591,168.

With regard to claims 1, Dall et al. disclose an apparatus having a connector (36b) with a superior end and an inferior end, at least a lateral side, a medial side opposite the lateral side, an anterior, and a posterior side opposing the anterior side, as seen in figure 9; at least one claw (90) at the superior end; at least one cable aperture (48) or surface groove along the connector extending from one side to another side of the connector, as recited in column 4, lines 40-45; and at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as recited in column 4, lines 3-28 and seen in figure 9.

However, Dall et al. do not recite a claw having at least one extension hook, the at least one extension or hook having at least one tooth adapted to impact into a bone of a body.

On the other hand, Judet et al. teach a device having a claw with at least one extension hook, as seen in figures 4 and 5 and clearly discussed above. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Dall et al. to provide a claw with at least one extension hook for the purpose of better grasping. Moreover, the phrase "adapted to impact into a bone of a body" is not given patentable weight in an apparatus claim. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Regarding claim 2, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose a superior end with a first transition portion that is detachable from a second transition portion of the inferior end, as recited in column 5, lines 5-12 and seen in figure 9.

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Regarding claim 3, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose an inferior end that is bowed or rotated to more properly align with a bone of a body, as recited in column 3, lines 65-67.

Regarding claim 4, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose a connector that includes a transition portion between the inferior end and the superior end to allow bending of the connector to more properly align with a bone of a body, as stated in column 5, lines 10-12 and seen in figure 10 (wherein most material can be bent to conform to the shape of a bone).

Regarding claim 5, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose a bone screw slot (44) that is located along the inferior end, as seen in figure 9.

Regarding claims 6 and 23, Dall et al. as modified by Judet et al. disclose that as applied to claims 1 and 21. Applicant's specification on page 10 recites, "Compression slots are generally known in the art." Applicant then defines a compression-type slot as that shaped such that as the bone screws are tightened, the screws are tightened, the screws will be biased in the slot towards the fracture line. Thus, although Dall et al. do not explicitly recite "compression-type slots," they are generally known in the art and would be obvious to one with ordinary skill in the art, as concluded by the specification on page 10.

Regarding claim 7, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose at least one bone screw (38, 58 and/or 68) that is engageable within the bone screw slot and within a bone of a body, as seen in figure 2.

Regarding claim 8, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose; a bone screw slot that is configured to angle a bone screw when it is inserted into the bone screw slot to avoid a prosthesis in a body, within the scope given the structure.

Regarding claim 9, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose; a superior end that includes a cable aperture (wherein the connection portion where 36b and 90 meet there are cable apertures as seen in figure 10, therefore considered part of the superior end).

Regarding claim 10, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose a cable aperture that is angled or on a curved path relative to the anterior and posterior sides of the superior end, as recited in column 4, lines 15-25 (also any degree even 90 degrees can be considered an angle).

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Regarding claim 11, Dall et al. as modified by Judet et al. disclose that as applied to claim 1, as well as, Dall et al. further disclose and a cable (64) insertable within the cable aperture, as seen in figures 9 and 10.

Regarding claims 12-15, 28-31, Dall et al. as modified by Judet et al. disclose that as applied to claims 1 and 16. However, Dall et al. do not explicitly recite at least one cable screw slot along the connector extending from the lateral side of the cable aperture; at least one cable screw each engageable with the respective cable screw slot and **capable** of crimp a cable within the cable aperture; a driver slot along the lateral side of the superior end; and a driver engageable with the driver slot. The phrase "capable of crimping" is not given patentable weight in an apparatus claim. It has been held that the recitation that an element is "capable" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138. Furthermore, it would be obvious to one with ordinary skill in the art to provide a driver slot along the lateral side and a driver engageable with the driver slot for the purpose of better enabling the driver, as discussed above.

Regarding claim 16, Dall et al. disclose an apparatus having a connector (36b) having a superior end and an inferior end, a lateral side, a medial side opposite the lateral side, an anterior side, and a posterior side opposing the anterior side; at least one cable aperture (48) along the connector, as seen in figures 9 and 10; at least one cable aperture (48) or surface groove along the superior end (wherein the connection portion where 36b and 90 meet there are cable apertures as seen in figure 10, therefore considered part of the superior end); and at least one claw member (90) at the superior end, as seen in figure 9.

However, Dall et al. do not recite a claw having at least one extension hook, the at least one extension or hook, the at least one extension or hook having at least one tooth adapted to impact into a bone of a body.

On the other hand, Judet et al. teach a device having a claw with at least one extension hook, as seen in figures 4 and 5 and clearly discussed above. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Dall et al. to provide a claw with at least one extension hook for the purpose of better grasping. Moreover, the phrase "adapted to impact into a bone of a body" is not given patentable weight in an apparatus claim. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Regarding claim 17, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose a superior end with a first transition portion that is detachable from a second transition portion of the inferior end, as recited in column 5, lines 6-13 and seen in figures 9 and 10.

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Regarding claim 19, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose an inferior end that is bowed or rotated to more properly align with a bone of a body, as recited in column 3, lines 65-67.

Regarding claim 20, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose a transition portion between the inferior end and the superior end to allow bending of the connector to more properly align with a bone of a body (wherein most material can be bent to conform to the shape of a bone).

Regarding claim 21, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as seen in figures 2 and 9.

Regarding claim 22, Dall et al. as modified by Judet et al. disclose that as applied to claim 21, as well as, Dall et al. further disclose a bone screw slot that is located along the inferior end, as seen in figure 9.

Regarding claim 24, Dall et al. as modified by Judet et al. disclose that as applied to claim 21, as well as, Dall et al. further disclose at least one bone screw (38, 58, and/or 68) engageable within the bone screw slot (44) and within a bone of a body, as recited in column 4, lines 5-29.

Regarding claim 25, Dall et al. as modified by Judet et al. disclose that as applied to claim 21, as well as, Dall et al. further disclose a bone screw slot (44) that is configured to angle a bone screw when it is inserted into the bone screw slot to avoid a prosthesis in a body, within the scope given the structure.

Regarding claim 26, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose a cable aperture (48) that is angled relative to a lateral side of the superior end, as stated in column 4, lines 15-20 (also any degree even 90 degrees can be considered an angle).

Regarding claim 27, Dall et al. as modified by Judet et al. disclose that as applied to claim 16, as well as, Dall et al. further disclose, and a cable (64) that is insertable within the cable aperture, as seen in figure 9.

Regarding claims 32, 33, and 35, see that stated above regarding the previous claims where the limitations are addressed.

Regarding claim 38, Dall et al. disclose a connector (36b) having a superior end with a first portion; an inferior end with a second portion (90) that is detachable mated to the first portion of the superior end, the inferior end having at least a lateral side, a

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medial side opposite the lateral side, an anterior, and a posterior side opposing the anterior side, as seen in figures 9 and 10; and at least one claw (90) at the superior end, as seen in figure 9.

However, Dall et al. do not recite a claw having at least one extension hook, the at least one extension or hook, the at least one extension or hook having at least one tooth adapted to impact into a bone of a body.

On the other hand, Judet et al. teach a device having a claw with at least one extension hook, as seen in figures 4 and 5 and clearly discussed above. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Dall et al. to provide a claw with at least one extension hook for the purpose of better grasping. Moreover, the phrase "adapted to impact into a bone of a body" is not given patentable weight in an apparatus claim. It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Regarding claim 39, Dall et al. as modified by Judet et al. disclose that as applied to claim 38, as well as, Dall et al. further disclose at least one cable aperture (48) or surface groove along the connector extending from one side to another side of the connector, as seen in figure 9.

Regarding claim 40, Dall et al. as modified by Judet et al. disclose that as applied to claim 39, as well as, Dall et al. further disclose at least one bone screw slot (44) along the connector extending from the lateral side to the medial side, as seen in figure 2.

Regarding claim 41, Dall et al. as modified by Judet et al. disclose that as applied to claim 39, as well as, Dall et al. further disclose; and an inferior end and a superior end that are mated by at least one bone screw, as seen in figure 9.

Regarding claims 42-45, Dale et al. as modified by Judet et al. disclose that as applied to claims 1, 16, 32, and 38. Further, the phrase that the claw is "adapted for use in the presence of an artificial hip implant" is not given patentable weight for it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Regarding claims 45-49, Dale et al. as modified by Judet et al. disclose that as applied to claims 1, 16, 32, and 38. Further, the phrase that the apparatus is "adapted to simultaneously repair a periprosthetic fracture of the femur and fracture of a greater trochanter" is not given patentable weight for it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchinson, 69 USPQ 138.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Odland whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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